

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAVIER VERDURA, JR. and
PETER BERTOLINI

Appeal No. 97-2464
Application 29/038,531¹

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge, and
JERRY SMITH and WEIMAR, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134
from the examiner's rejection of the following design claim:

¹ Application for patent filed May 8, 1995.

Appeal No. 97-2464
Application 29/038,531

The ornamental design for a BOTTLE as shown and described.

The bottle design is depicted in perspective view, front or rear elevational view, right or left side elevational view, top plan view, and bottom plan view in Figures 1-5, respectively.

The examiner relies on the following references:

Brenner	Des. 94,069	Dec. 18, 1934
Desgrippes et al. (Desgrippes)	Des. 332,406	Jan. 12, 1993

Coupon for Vaseline® Intensive Care® Lotion bottle, published in the Washington Post on or before May 1990 (the Coupon).

The design claim stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the Coupon in view of Desgrippes and Brenner. A rejection of the claim under the second paragraph of 35 U.S.C. § 112 was withdrawn by the examiner in an Advisory Action mailed May 10, 1996.

Rather than repeat the arguments of appellants or the examiner, we make reference to the brief and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into

consideration, in reaching our decision, the appellants' arguments set forth in the brief along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the collective evidence relied upon and the level of skill of the designer in this particular art would not have suggested to the designer of ordinary skill in the art the obviousness of the design claim before us. Accordingly, we reverse.

The examiner has pointed out what each of the prior art references teaches and has indicated how and why these references would have been combined to arrive at the claimed invention. The examiner has, therefore, at least satisfied the burden of presenting a prima facie case of obviousness. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

Initially, we point out that in a proper rejection of a design claim under 35 U.S.C. § 103, there is the requirement that there must be a reference (the basic design), a something in existence, the design characteristics of which are basically the same as the claimed design in order to support a holding of obviousness. In other words, the basic reference design must

look something like the claimed design. See In re Harvey, 12 F.3d 1061, 1063, 29 USPQ2d 1206, 1208 (Fed. Cir. 1993) and In re Rosen, 673 F.2d 388, 391, 213 USPQ 347, 350 (CCPA 1982). Once such a basic design reference has been established, features thereof might reasonably be interchanged with or added from those in other pertinent references to achieve the claimed design. Such modifications, however, cannot destroy fundamental characteristics of the basic design reference. The long standing test for the proper combination of references has been whether they are so related that the appearance of certain ornamental features in one would suggest the application of those features in the other. In re Rosen, supra.

We also keep the following principles clearly in mind when evaluating the obviousness of a claimed design. The proper standard under 35 U.S.C. § 103 is whether the design would have been obvious to a designer of ordinary skill of the articles involved. Note In re Nalbandian, 661 F.2d 1214, 1216, 211 USPQ 782, 784 (CCPA 1981). Further it is the overall appearance of a design, that is the visual effect as a whole of the design, which must be taken into consideration. In re Rosen, supra. However, while the obviousness of a design must be evaluated as a whole, the evaluation of the whole necessarily involves consideration of

Appeal No. 97-2464
Application 29/038,531

what are indicated to be the distinguishing features of the claimed design. See Petersen Manufacturing Co., Inc. v. Central Purchasing, Inc., 740 F.2d 1541, 1548, 222 USPQ 562, 567 (Fed. Cir. 1984). Additionally, when considering the patentability of a design, the mere fact that there are differences between the design and a prior art design is not alone sufficient to justify the patentability of the design. In re Lamb, 286 F.2d 610, 611, 128 USPQ 539, 539 (CCPA 1961). It is the distinctiveness in overall appearance of a design when compared to a prior art design, rather than minute details or small variations in configuration, which constitutes the test for design patentability. In re Lapworth, 451 F.2d 1094, 1096, 172 USPQ 129, 131 (CCPA 1971).

We now consider how these principles and the arguments made by appellants and the examiner affect our decision based upon the record before us.

Our first observation is that the Coupon appears to be an acceptable something in existence, the design characteristics of which are basically the same as the claimed design. In other words, it is apparent to us that the Coupon is a Rosen type reference. Appellants have not specifically challenged the use

of the Coupon as a basic reference, and we will treat this particular issue as not contested.

The examiner cites the Coupon as disclosing a bottle "that is the same as the claimed design except that it lacks the horizontal ribs on the sides" [answer, page 3]. Desgrippes was cited to show a bottle having raised horizontal ribs on the sides that are similar to the ones used by appellants. Finally, the examiner cites Brenner to show horizontal ribs on a bottle confined to the midsection of the sidewalls. With these three references available, the examiner stated the rejection as follows:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the "Vaseline" lotion bottle by providing raised horizontal ribs like the ones shown by Desgrippes on the midsection of the sidewall as suggested by Brenner. Moreover, to do so would result in a bottle that is strikingly similar to the claimed design and no patentable ornamental advance is seen thereover.
[answer, page 4]

Appellants basically argue that each of the cited references is substantially different from the claimed design, the examiner's rejection represents a hindsight reconstruction of the claimed design, and a combination of the cited art would not result in the present invention [brief, pages 4-7]. We agree at

least with appellants' assertion that the proposed combination of the examiner appears to be nothing more than a hindsight reconstruction of the invention.

It appears to us that the examiner has selectively chosen certain design features of the cited references while deliberately ignoring other design features of the references just so the claimed design would result. The Brenner design suggests that the midsection of the bottle where the horizontal ribs are placed should be curved to give the impression of an actual belted waistline. The examiner ignores this part of the Brenner design, however, and seeks to use only the ribs themselves without the bottle shape. This selective use of the design characteristics of the prior art suggests that it is driven by a hindsight reconstruction of the invention rather than the objective teachings of the references. There is nothing on this record to suggest that the bottle designer would consider the use of midsection ribs without the corresponding waistline shape. Such an ornamental appearance is very different from the claimed design which seeks to give the illusion of a waistline without sacrificing the interior volume of the bottle. We are of the view that the bottle designer of ordinary skill having the applied references available would not have combined them in a

Appeal No. 97-2464
Application 29/038,531

manner to arrive at the claimed design without the aid of appellants' own disclosure.

In summary, we agree with appellants that the selective combination of design features of the applied references is driven not by the teachings of the references, but rather by an effort to reconstruct the claimed invention using appellants' own disclosure. Therefore, we do not sustain the rejection of the design claim before us.

The decision of the examiner is reversed.

REVERSED

)	
HARRISON E. McCANDLISH)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
JERRY SMITH)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES

Appeal No. 97-2464
Application 29/038,531

ELIZABETH C. WEIMAR)
Administrative Patent Judge)

PATENT DEPARTMENT
Unilever United States Inc.
45 River Road
Edgewater NJ 07020